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EXAMINER	
FERTIG, BRIAN E	

ART UNIT	PAPER NUMBER
3694	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/757,940	MOORE ET AL.	
	Examiner	Art Unit	
	BRIAN FERTIG	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to Applicant's filing of 9/23/3008. Claims 1-16 are pending and examiner below. Claim 16 is new.

Claim Objections

1. Claims 1, 7 and 16 are objected to because of the following informalities: These claims contain limitation directed to optional steps. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see MPEP § 2106). Examiner respectfully suggests omission of the optional and 'if' language in the claim and instead recite positive limitations, such as 'wherein manually entered price data is processed by the steps comprising:' and 'wherein omitted price data is obtained through a process of: . . .', and including in each wherein clause processing steps pertaining that the particular type of data. Applicant may also wish to consider a clause directed to the common processing steps of both the manually entered and retrieved data together.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are directed to a process (method). The Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130, has affirmed that a statutory process must (1) be tied to another statutory class

(such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (i.e. the machine-or-transformation test). To qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

Applicant is also directed to MPEP § 2173.05p, providing guidance with respect to reciting a product and process in the same claim and MPEP § 2111.02 [R3] providing guidance with respect to the effect of limitations within the preamble of a claim.

Examiner notes that the 'input' and 'structure' and other similar recitations in the claims below, when given their broadest reasonable meanings, read on software structures such as input wizards and do not limit the recited claims to the 'particular apparatus' contemplated in Bilski.

To the degree supported by Applicant's Specification, Examiner respectfully suggests the inclusion of a positively recited processing step by a machine of the pricing system (i.e. financial institution) and/or a positively recited step relating to determining whether a price had been entered by the hardware device into which the user enters the pricing information.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-7, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,787,402 to Potter (Potter).

With respect to claim 1

Potter teaches:

A method for pricing a trade comprising:

providing a user input for entering trade data (inputting information, see col 3, line 22);

providing a structure for receiving said trade data (new order entry screen, see col 13, lines 34-43 and Fig 24);

providing a user input for optionally manually entering pricing data (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combination of these teaching, therefore fairly suggests an input for manually entering pricing data. Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that it is capable. See also col 3, lines 43-45 teaching the storage and recall of recurring transaction details, further supporting the teaching of optionally manually entering orders);

if pricing data has been manually entered by the user, adding the pricing data to the structure (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that the teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combined

teaching fairly suggests that a manually entered order would be added to the pricing structure as a natural processing progression in a system with combined manual and automatic features);

if the user has not manually entered pricing data, transmitting said structure to a pricing system (request a spot rate, see col 7, lines 44-52, note that this branch follows the automatic order suggested by col 5, lines 15-21);

if the user has not manually entered pricing data, receiving said structure from said pricing system (the FX Trade Server then relays the requested rate quotation to the client PC, see col 7, lines 53-67); and

displaying said structure with said trade data including pricing information (when the rate is received, the Term of the currency will be displayed, see col 8, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have combined the manual ordering features recited by Potter as being in the prior art with the automated features of Potter in order to accommodate automatic and manual orders as taught explicitly by Potter (see col 5, lines 15-21). While Potter discloses the disadvantage of manual processing as being labor intensive, Potter also contemplates his system as being capable of both automatic and manual order, suggesting that he acknowledges the advantages of bridging the gap between prior art and state of the art processing techniques.

With respect to claim 4

Potter teaches:

> A method in accordance with claim 1 (see rejection of claim 1 above) wherein providing a user input for entering one or more wades comprises translating data representing one or more trades from a user treasury system into a form suitable for use in said structure (inputting information, see col 3, line 22. Note that the input action translates the conceptual order, including the goals and aims of the purchaser, into the specific inputs to be processed by the system).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 5

Potter teaches:

> A method in accordance with claim 1 (see rejection of claim 1 above) wherein displaying said structure comprises translating data from said structure into data representing one or more trades in a user treasury system (transaction view, see col 10, lines 51-60 and Fig 18).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 6

Potter teaches:

> A method in accordance with claim 1 (see rejection of claim 1 above) wherein providing a user input for entering trade data comprises providing a user input for entering trade data directly into said structure (various terminals, see col 3, lines 20-26).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 7

Potter teaches:

A method for pricing a trade comprising:

providing a user input for entering trade data into a structure at a user system (inputting information, see col 3, line 22);

providing a user input for optionally entering pricing data into the structure at the user system (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combination of these teaching, therefore fairly suggests an input for manually entering pricing data. Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that it is capable.);

if pricing data has not been entered at the user system, transmitting said structure to a pricing system (request a spot rate, see col 7, lines 44-52, in combination with col 5, lines 15-21, note that this branch is following the automatic order suggested by Potter);

if the user has not manually entered pricing data, pricing said trade data at said pricing system (system then automatically generates an offer, see col 3, lines 26-31);

if the user has not manually entered pricing data, adding said pricing data to said structure at said pricing system (stores a time-stamped copy of the rate quotation, see col 7, lines 53-56);

if the user has not manually entered pricing data, transmitting said structure to said user system (relays the requested rate quotation to the client PC, see col 7, lines 53-67); and

displaying said trade data and said pricing data at said user system (the Term of the currency will be displayed by the client, see col 8, lines 1-5).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 12

Potter teaches:

A method in accordance with claim 7 (see rejection of claim 7 above) wherein providing a user input for entering trade data comprises translating data representing one or more trades from a user treasury system into a form suitable for use in said structure (inputting information, see col 3, lines 22. Note that the input action translates the conceptual order, including the goals and aims of the purchaser, into the specific inputs to be processed by the system).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 13

Potter teaches:

> A method in accordance with claim 7 (see rejection of claim 7 above) wherein displaying said structure comprises translating data from said structure into data representing one or more trades in a user treasury system (transaction view, see col 10, lines 51-60 and Fig 18).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 14

Potter teaches:

> A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: storing said trade data at said pricing system (stores a time-stamped copy of the rate quotation, see col 7, lines 53-56).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 15

Potter teaches:

> A method in accordance with claim 14 (see rejection of claim 14 above) further comprising: executing one or more trades using said trade data stored at said pricing system (the FX Trade Server sends a copy of the trade to the Multibank Confirmation and Settlement System, see col 8, lines 19-67).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 16

Potter teaches:

A method for pricing a trade comprising:

providing a user input for entering trade data (inputting information, see col 3, line 22);

providing a structure for receiving said trade data (new order entry screen, see col 13, lines 34-43 and Fig 24);

providing a user input for optionally manually entering pricing data (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combination of these teaching, therefore fairly suggests an input for manually entering pricing data. Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that it is capable.);

if pricing data has been manually entered by the user, adding the pricing data to the structure (see col 5, lines 15-21 in combination with col 2, lines 17-34, note that the teaching contemplates a combination of automatic and manual orders and specifically teaches manually determining price data as the method of the prior art. The combined

teaching fairly suggests that a manually entered order would be added to the pricing structure as a natural processing progression in a system with combined manual and automatic features);

if pricing data has been manually entered by the user, displaying said structure with said trade data including pricing information devoid of encrypting and decrypting of said structure (the Term of the currency will be displayed by the client, see col 8, lines 1-5, note there is no encryption or decryption taking place.);

if the user has not manually entered pricing data, transmitting said structure to a pricing system (request a spot rate, see col 7, lines 44-52, in combination with col 5, lines 15-21, note that this branch is following the automatic order suggested by Potter);

if the user has not manually entered pricing data, receiving said structure from said pricing system (the FX Trade Server then relays the requested rate quotation to the client PC, see col 7, lines 53-67); and

displaying said structure with said trade data including pricing information (the Term of the currency will be displayed by the client, see col 8, lines 1-5).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

7. Claims 2-3 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter in view of US Patent Application Publication 2002/0156719 to Finebaum (Finebaum).

With respect to claim 2

Potter teaches:

> A method in accordance with claim 1 (see rejection of claim 1 above), but does not explicitly teach further comprising: encrypting said structure before transmitting said structure to a pricing system.

Finebaum teaches:

> further comprising: encrypting said structure before transmitting said structure to a pricing system (see par 31 and 50).

It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have provided Potter with the encryption features taught by Finebaum in order to have allowed only authorized users to access the system as taught explicitly by Finebaum (see par 31).

With respect to claim 3

Potter in view of Finebaum teaches:

> A method in accordance with claim 1 (see rejection of claim 1 above) further comprising: decrypting said structure after receiving said structure from said pricing system (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

(see rational supporting obviousness and motivation to combine of claim 2 above).

With respect to claim 8

Potter in view of Finebaum teaches:

> A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: encrypting said structure at said user system before transmitting said structure to said pricing system (see Finebaum, par 31 and 50).

(see rational supporting obviousness and motivation to combine of claim 2 above).

With respect to claim 9

Potter in view of Finebaum teaches:

> A method in accordance with claim 8 (see rejection of clam 8 above) further comprising: decrypting said structure at said pricing system after receiving said structure from said user system. (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

(see rational supporting obviousness and motivation to combine of claim 2 above)

With respect to claim 10

Potter in view of Finebaum teaches:

> A method in accordance with claim 7 (see rejection of claim 7 above) further comprising: encrypting said structure at said pricing system before transmitting said structure to said user system(see Finebaum, par 31 and 50).

(see rational supporting obviousness and motivation to combine of claim 2 above)..

With respect to claim 11

Potter in view of Finebaum teaches:

> A method in accordance with claim 10 (see rejection of claim 10 above) further comprising: decrypting said structure at said user system after receiving said structure from said pricing system. (see Finebaum par 31 and 50, note that it is inherent in an encrypted communication system that the intended receiver of the communication decrypt it.)

(see rational supporting obviousness and motivation to combine of claim 2 above)

Response to Arguments

8. Applicant's arguments filed 9/23/2008 have been fully considered but they are not persuasive.

9. With respect to Applicant's argument that Potter does not teach or suggest "providing a user input for optionally manually entering pricing data," in combination with the other recited features of independent claims 1 and 7 and that Finebaum fails to remedy this deficiency, Examiner respectfully disagrees. Potter teaches an invention that is capable of both automatic and manual orders (see col 5, lines 15-21). Potter also teaches that manual processing or order, including the manual pricing of orders (see col 2, lines 18-34) and the storing and recalling of previously entered data (see col 3, lines 43-45). The combined teaching fairly suggests providing a user input for optionally entering pricing data in so far as Potter contemplates his system as being capable of both automatic and manual order, suggesting that he acknowledges the advantages of bridging the gap between prior art and state of the art processing techniques and allows

for pricing order manually to accommodate the prior art practice. Applicant further argues that the claimed invention is differentiated from the teaching of Potter in so far as Potter teaches the manual processing of orders, but is silent with respect to pricing data. Examiner respectfully observes that, as claimed, 'pricing data' is not functional descriptive material. As such, the nature of the data (i.e. that the data is 'pricing data') is not given distinguishing patentable weight since the nature of the data is not claimed so as to cause any difference in the processing steps of the claimed invention. For example, as claimed, the data could be replaced with any other arbitrary data, and the processing method would be carried out the same. Examiner respectfully suggests the inclusion of a positively claimed step that depends on the nature of the data as pricing data in the execution of that step. For example, the combined processing steps of determining whether pricing data has been entered or omitted and the suggested wherein clause (see above) limiting the processing/obtaining of the omitted pricing data from a pricing system apparatus. As such the determination step could depend on the nature of the data as 'pricing data' since the omitted pricing data must be sent to a pricing system for retrieval and not to any arbitrary system.

Note further that the 'for' clause is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The disclosure of a combination of automatic and manual orders suggest that Potter's invention is capable.

10. With respect to Applicant's argument that the dependent claims are allowable for their incorporation of subject matter claimed in the independent claims, Examiner disagrees in light of the discussion above.

Examination Note

11. In addition to the comments and suggestions above, Examiner respectfully observes as a general matter that Applicant's claimed invention contains no positively recited data processing steps upon which Examiner can base patentability. Examiner also observes that Applicant's arguments are directed toward distinguishing features based providing a user with an 'option'. As described above, optional steps do not particularly limit Applicant's claimed invention. Examiner respectfully suggests that patentability cannot be based on an optional step, but must, instead be based on a positively recited limitation.

Inquiry

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (271)570-5131. The examiner can normally be reached M-F 8:00-5:00 EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/
Primary Examiner, Art Unit 3694